

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ALEJANDRO WIECHERS

Appeal 2007-1120
Application 09/747,219
Technology Center 2100

Decided: June 19, 2007

Before KENNETH W. HAIRSTON, HOWARD B. BLANKENSHIP, and
ALLEN R. MACDONALD, *Administrative Patent Judges*.

HAIRSTON, *Administrative Patent Judge*.

DECISION ON APPEAL
STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from a final rejection of claims 1, 3, 4, 7 to 9, 11, 12, 14, and 21 to 26. We have jurisdiction under 35 U.S.C. § 6(b).

Appellant has invented a system and method of coding an electronic file. After a received electronic file is stored in memory, it is assigned a

classification code based on classification information and it is assigned an inventory code based on whether the electronic file already exists in the system. Based on both the classification code and the inventory code, the electronic file is assigned an identification code. Thereafter, the electronic file is edited to include the identification code (Figure 1; Specification 3 and 4).

Claim 1 is representative of the claims on appeal, and it reads as follows:

1. A system for coding an electronic file, comprising:

a reference repository, wherein the reference repository receives the electronic file and characteristic information associated with the electronic file from a communications network and stores the characteristic information in a memory;

an indexing unit linked with the reference repository, wherein the indexing unit assigns a classification code to the electronic file based on the characteristic information, assigns an inventory code to the electronic file based on whether the electronic file already exists in the system, and compiles an identification code for the electronic file from the classification code and the inventory code; and

an editing unit linked with the reference repository and the indexing unit, wherein the editing unit inserts the identification code to the electronic file.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Van Huben	US 6,327,594 B1	Dec. 4, 2001 (filed Jan. 29, 1999)
Seder	US 6,522,770 B1	Feb. 18, 2003 (filed Aug. 1, 2000)

The Examiner rejected claims 1, 3, 4, 7, 8, 21, 22, and 25 under 35 U.S.C. § 102(e) based upon the teachings of Seder. The Examiner rejected

claims 9, 11, 12, 14, 23, 24, and 26 under 35 U.S.C. § 103(a) based upon the teachings of Seder and Van Huben.

Appellant contends that Seder describes a system wherein a machine-readable indicia added to a printed document can be used to retrieve an electronic version of the printed document (Br. 6). Appellant additionally contends that the Seder system neither teaches nor suggests coding an electronic file in the manner set forth in the claims on appeal (Br. 6).

We reverse.

ISSUES

Does Seder encode and edit an electronic file with classification information and inventory information?

FINDINGS OF FACT

Appellant describes a system 10 for coding an electronic file (Fig. 1). The system includes a reference repository 33 that receives an electronic file and characteristic information associated with the electronic file from a communications network 20, and stores the characteristic information in memory (Specification 5 and 6). An indexing unit 100' linked with the reference repository 33 assigns a classification code to the electronic file based on the characteristic information, and assigns an inventory code to the electronic file based on whether the electronic file already exists in the system (Specification 7). An identification code for the electronic file is derived based on the classification code and the inventory code (Specification 8). Thereafter, an editing unit 200' inserts the identification code to the electronic file (Specification 8).

Seder describes a system in which an encoded mark on a printed document is scanned to thereby retrieve an electronic version of the printed

document that may be displayed and edited (Abstract; col. 1, ll. 52 to 56; col. 2, ll. 11 to 18; col. 4, ll. 8 to 14). The encoded mark includes characteristic information (e.g., the author¹ of the printed document) (col. 1, l. 36; col. 2, l. 61). The encoded mark in Seder also indexes data (col. 2, ll. 56 to 59; col. 6, ll. 29 to 44), and stores the latest revision number of the electronic version of the printed document (col. 7, ll. 59 to 66). Seder is silent as to assigning “an inventory code” to an electronic file undergoing encoding “based on whether the electronic file already exists in the system” or is “a copy of an existing electronic file.”

Van Huben was cited by the Examiner for a description of software procedures that are “library-specific” (Answer 8).

PRINCIPLES OF LAW

Anticipation is established when a single prior art reference discloses expressly or under the principles of inherency each and every limitation of the claimed invention. *Atlas Powder Co. v. IRECO Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1946 (Fed. Cir. 1999); *In re Paulsen*, 30 F.3d 1475, 1478-79, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

The Examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The Examiner’s articulated reasoning in the rejection must possess a rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006).

¹ Appellant’s disclosure lists an author as characteristic information (Specification 6).

ANALYSIS

We agree with Appellant that Seder does not teach encoding an electronic file with an identification code that is based on both a classification code and an inventory code.

CONCLUSIONS OF LAW

Anticipation has not been established by the Examiner because Seder does not disclose each and every limitation of the claimed invention set forth in claims 1, 3, 4, 7, 8, 21, 22, and 25.

Obviousness has not been established by the Examiner because the applied references to Seder and Van Huben neither teach nor would have suggested to one of ordinary skill in the art the subject matter set forth in claims 9, 11, 12, 14, 23, 24, and 26.

DECISION

The anticipation rejection of claims 1, 3, 4, 7, 8, 21, 22, and 25 is reversed. The obviousness rejection of claims 9, 11, 12, 14, 23, 24, and 26 is reversed.

REVERSED

tdl/ce

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